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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,403	10/21/2003	Hiroki Moriyama	17137	5951
23389	7590	03/26/2007		
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER REKSTAD, ERICK J	
			ART UNIT 2621	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/690,403

Applicant(s)

MORIYAMA, HIROKI

Examiner

Erick Rekstad

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/21/03 + 02/20/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is a First Office Action for Application no. 10/690,403 filed on October 21, 2003 wherein claims 1-20 are presented for examination.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[claims 6 and 7]

Using the following defined variables:

L=Large-Diameter of first Endoscope

S=Small-Diameter of first Endoscope

2=Diameter of Second Endoscope

3=Diameter of Third Endoscope

Claim 1 requires:

$S < L$  and  $3 \leq 2$

Claims 6 and 7 require  $S = 3$

This is not possible in the situation where:  $2 = L$  because then  $3 = L$  but  $S$  can not equal  $L$ .

[claims 8-20]

Using the above defined variables, Claim 1 requires:

$S < L$  and  $3 \leq 2$

At a minimum claims 2-5 require  $L = 2 = 3$

Therefore,  $S \neq 2$  and  $S \neq 3$ . Claims 8-20, all contain a variation of requiring S to equal 3 which is not possible based on the requirements of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,885,208 to Moriyama in view of US Patent 4,690,175 to Ouchi et al.

[claim 1]

As shown in Figure 10, Moriyama teaches the use of multiple sized endoscopes (7, 207, 307, 407). The endoscopes each share the video processor (4) and light source (3)(Col 19 Lines 13-16). Moriyama further teaches the soft portion (13, 213, 313, 413) each at different diameters (Col 19 Lines 25-29, 40-41 and 45-47). Moriyama further teaches the use of varying softness for the endoscopes (Figs. 23, 24, 26, 27, 29-33). Moriyama is silent of the use of a small diameter and a large diameter for the outer diameter for any of the soft portion (13, 213, 313, 413).

Ouchi teaches the use of flexible tubes for use with endoscopes to vary the flexibility of the endoscope tube (Abstract). Ouchi specifically teaches the use of a small diameter(A) and a large diameter(B) in order to vary the flexibility (Fig. 1 and 5,

Col 7 Lines 13-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an endoscope using the flexible tubing of Ouchi with the endoscope system of Moriyama in order to provide an endoscope with varying flexibility as taught by Ouchi (Abstract).

[claims 2-5]

Ouchi further teaches the use different tubes for varying flexibility (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to use different designs for the endoscope tubes in order to provided desired flexibility in the endoscope system of Moriyama as taught by Ouchi (Abstract, Figs. 1, 2 and 5).

[claims 6-20]

As best understood by the examiner with respect to the above 112 rejection, Moriyama teaches the use of multiple endoscopes at varying diameters (Col 19, Lines 25-29, 40-41 and 45-47). Moriyama further teaches providing a variety of flexibility (Figs. 23, 24, 26, 27, 29-33). Ouchi teaches the use of flexible tubing to provide varying flexibility to an endoscope (Abstract, Figs. 1, 2, and 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a combination of endoscopes with varying diameters and flexibility as taught by Moriyama and Ouchi.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,117,128 to Gregory.


US Patent 6,572,538 to Takase.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erick Rekstad whose telephone number is 571-272-7338. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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